

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed April 16, 2004 ("Office Action"). At the time of the Office Action, Claims 1-13 were pending in the application. In the Office Action, the Examiner rejects Claims 1-13. Applicant amends Claim 11 to correct a typographical error. Applicant respectfully requests reconsideration and favorable action in this case.

Information Disclosure Statement

An Information Disclosure Statement (IDS) and accompanying PTO-1449 form were submitted on April 6, 2004. The Examiner has not provided an indication that the submitted references were considered by the Examiner. For the Examiner's convenience, Applicant has enclosed copies of the previously submitted IDS and PTO-1449 form. Additionally, Applicant has included a copy of the date-stamped postcard indicating the submission of the IDS. Applicant respectfully requests that the Examiner consider the cited references, if not already considered, and provide the appropriate indication that they have been considered by initialing next to the references on the PTO-1449 form.

Drawing Objections

The Examiner objects to the drawings under 37 C.F.R. § 1.84(n)(o). According to the Examiner, the drawings fail to show necessary textual labels of features or symbols in Figure 2 as described in the specification. Applicant respectfully traverses the Examiner's objection to Figure 2. Applicant submits that the depictions associated with reference numerals 34 and 36 on Figure 2 are not symbols within the meaning of 37 C.F.R. § 1.84. Instead, the depictions associated with reference numerals 34 and 36 are actual graphical depictions of pruning indicator 34 and sibling pruning indicator 36, respectively, as the indicators might appear on a graphical user interface screen. As described in the Specification, Figure 2 is "a diagram on one embodiment of a user interface that may be used in conjunction with the teachings of the present invention." (Page 4, lines 7-8). Accordingly, Applicant submits that the depictions associated with reference numerals 34 and

36 are not used to represent objects; rather, the depictions are the objects. For at least these reasons, Applicant respectfully requests that the objection to the drawings be withdrawn.

Should the Examiner maintain the objection to Figure 2 under 37 C.F.R. § 1.84, however, Applicant agrees to amend Figure 2 to include labels, a key, or other textual identification of pruning indicator 34 and sibling pruning indicator 36. Applicant requests, however, that for prosecution of this Application the Examiner consider the drawings as originally filed. Should the Examiner maintain the objection and require amendment to Figure 2, Applicants will file a revised Figure 2 when the Examiner indicates that the Application includes allowable subject matter.

Objection to the Specification

The Examiner objects to the Specification for a typographical error. Applicant has amended the paragraph beginning “The display engine 18 may . . .” on Page 6, of the Specification to correct the typographical error identified by the Examiner. Additionally, Applicant has amended the paragraph beginning “FIGURE 1 is a schematic . . .” on Page 5, of the Specification and the paragraph beginning “FIGURE 2 illustrates a pruned bill . . .” on Page 6, of the Specification to correct other typographical errors identified by Applicant when reviewing the Application in preparation of this Response. Accordingly, Applicant respectfully requests that the objection to the Specification be withdrawn.

Section 103 Rejections

The Examiner rejects Claims 1-3, 5-9, 11, and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,105,062 issued to Andrews et al. (“*Andrews*”). Applicant respectfully traverses these rejections for the reasons stated below.

First, Applicant respectfully submits that the proposed *Andrews-Walsh* combination does not disclose each and every feature recited in Applicant's claims. Independent Claim 1, of the present Application, recites as follows:

A method for processing data elements stored in a data set, comprising:

- organizing the data elements in a directory structure including identifying particular elements with particular directories;

- identifying particular elements within the data set in response to search criteria; and

- formatting a tree table associated with the data set and associated with a display where information associated with the identified data elements is displayed in the context of information associated with an immediate parent directory of the identified data elements and where a pruning indicator display element is included as a portion of the display to indicate to a user that at least one directory structure associated with the immediate parent directory exists within the directory structure but has been omitted from the display.

As one example, Applicant respectfully submits that the proposed *Andrews-Walsh* combination does not disclose, teach, or suggest “identifying particular elements within the data set in response to search criteria,” as recited in Claim 1. The Examiner has specifically relied on *Andrews* for disclosure of the above-recited features. *Andrews* merely discloses, however, a system for “manag[ing] network entities through the use of a directory tree.” (Column 1, lines 6-8). More specifically, *Andrews* discloses:

Sometimes it is necessary for an administrator to copy or move one or more objects from one location in a directory tree to another location in a directory tree. For example, during corporate reorganizations it is not unusual to have to reorganize operating units. In such an instance, it is desirable to modify the directory tree to reflect the layout of the reorganized organization. Rather than individually moving each object, which could entail hundreds of individual move operations, it would be desirable to move subtrees of objects in a single move operation . . .

(Column 6, lines 8-17). Thus, *Andrews* merely discloses a system that allows for the movement of objects within a directory tree. To perform the movement or reorganization, *Andrews* discloses that a display device 27 “is coupled to server 20, and a graphical representation of a directory tree 29 illustrates a hierarchical tree of various objects associated with the organization’s network.” (Column 5, lines 37-41). A user identifies the subtree to be moved by “utiliz[ing] a user selection device, such as a mouse, to select the subtree to move.” (Column 7, line 67 through Column 8, line 1). “The user can select the root node of the subtree that it wishes to move and indicate via a button for example, that a move operation is desired.” (Column 8, lines 1-3). After the subtree is identified, a destination

location and destination object are similarly identified. (Column 8, lines 9-18). Thus, the user manually identifies and selects the subtree that the user wishes to move. Accordingly, Applicant respectfully submits that the proposed *Andrews-Walsh* combination does not disclose, teach, or suggest “identifying particular elements within the data set *in response to search criteria*,” as recited in Applicant’s Claim 1.

As another, example, Applicant respectfully submits that the proposed *Andrews-Walsh* combination does not disclose, teach, or suggest that “a pruning indicator display element is included as a portion of the display to indicate to a user that at least one directory structure associated with the immediate parent directory exists within the directory structure but has been omitted from the display,” as recited in Applicant’s Claim 1. The Examiner has acknowledged that *Andrews* does not disclose the recited features; rather, the Examiner relies on *Walsh* for disclosure of the pruning indicator display element. *Walsh* merely discloses, however, a method for graphically displaying a UNIX directory structure that “includes the steps of identifying a base UNIX directory, and obtaining a list of entries in the base UNIX directory, including all files, all subdirectories, and all files and subdirectories in the subdirectories.” (Column 1, lines 32-37). “An HTML document is then built for displaying all the entries in the data structure in a hierarchical graphical directory structure pane in a web page.” (Column 1, lines 41-43). Thus, the graphical display disclosed in *Walsh* lists all directories, subdirectories, and sub-subdirectories.

The graphical display of *Walsh* uses three different symbols. A first symbol, an inverted triangle, is used “to indicate that the contents of that directory is displayed.” (Column 2, lines 22-24). A second symbol, a standing triangle, indicates “that the contents of the subdirectory is not displayed, and that by clicking on the subdirectory name or the symbol with a pointing device, such as a mouse or touch pad, the contents of the subdirectory will be displayed.” (Column 2, lines 29-33). A third symbol, a diamond, indicates a file within a subdirectory. (Column 2, lines 35-36). “In this manner, each UNIX directory and subdirectory displayed in directory structure pane 20 can be shown graphically with contents fully displayed (expanded) or hidden (collapsed), the state of which is indicated with the proper leading symbols.” (Column 2, lines 37-41). Thus, the symbols used in the graphical display disclosed in *Walsh* merely indicate whether the contents of each directory,

subdirectory, and sub-subdirectory are completely displayed or completely hidden. Each directory, subdirectory, and sub-subdirectory is listed. The graphical display disclosed in *Walsh* limits the user to completely displaying or completely hiding the contents of the directories. *Walsh* does not disclose, teach, or suggest “a pruning indicator display element is included as a portion of the display to indicate to a user that at least one directory structure associated with the immediate parent directory exists within the directory structure but has been omitted from the display,” as recited in Applicant’s Claim 1.

Second, assuming for purposes or argument that the proposed combination discloses the limitations of Applicant’s claims, which Applicant disputes, it would not have been obvious to one skilled in the art to make the combination. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The showing must be clear and particular. *See, e.g., C.R. Bard v. M3 Sys., Inc.*, 48 USPQ.2d 1225, 1232 (Fed. Cir. 1998). The Examiner has not provided adequate evidence of the required motivation or suggestion to make the proposed combination. The Examiner merely speculates “it would have been obvious” to make the proposed combination to “indicate to a user the contents of the directory, subdirectory is fully expanded or collapsed so as to enable the user to easily navigate through the different levels of components and subcomponents of the directory with a minimum amount of information and determine status in addition to setting for elements to be managed within a displayed hierarchical directory system.” (Office Action, page 4). The Examiner has not shown any motivation to combine and instead simply relies upon hindsight.

It is improper for an Examiner to use hindsight having read the Applicant’s disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Because the Examiner has merely used Applicant’s claims as an instruction manual to piece together the network management system disclosed in *Andrews* with the symbols disclosed in

Walsh, Applicant respectfully submits that the proposed *Andrews-Walsh* combination is improper and should not be used here to reject Applicant's claims.

Furthermore, even if the proposed *Andrews-Walsh* combination is proper, which Applicant disputes, the proposed combination would not result in Applicant's claimed invention. To the contrary, *Andrews* discloses a network management system that allows a user to move a subtree of directory objects from a source directory to a destination directory. (Column 2, lines 59-61). Because the symbols used in *Walsh* merely indicate whether the contents of each directory, subdirectory, and sub-subdirectory are completely displayed or completely hidden, and each directory, subdirectory, and sub-subdirectory is listed with the appropriate symbol, a combination of the two references merely results in a system that allows a user to move directory objects within a hierarchical structure wherein the Thus, the proposed combination would not result in Applicant's claimed invention as neither *Andrews* nor *Walsh* disclose a "pruning indicator display element . . . to indicate to a user that at least one directory structure associated with the immediate parent directory exists within the directory structure but has been omitted from the display," as recited in Applicant's claims.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1.

The Examiner also relies on the *Andrews-Walsh* combination to reject independent Claims 6 and 11. Applicant respectfully submits that the proposed *Andrews-Walsh* combination does not disclose, teach, or suggest each and every element of Applicant's independent claims. For example, Claim 6 recites "a search and control engine in communication with the user interface and operable to perform searches on the data set to identify particular data elements responsive to information received from the user via the user interface." Claim 6 also recites "a pruning indicator display element is displayed associated with each particular identified data element which is displayed in a fashion that omits at least one parent directory associated with the particular element." Claim 11 recites "identifying particular elements within the data set in response to search criteria" and "formatting a tree table associated with the data set . . . where a pruning indicator display element is included as a portion of the display to indicate to a user that at least one directory structure associated

with the immediate parent directory exists within the directory structure but has been omitted from the display.” Thus, for reasons similar to those discussed above with regard to Claim 1, Applicant respectfully submits that neither *Andrews* nor *Walsh* disclose, teach, or suggest each and every element as set forth in Applicant's independent Claims 6 and 11.

Dependent Claims 2-3 and 5 depend from independent Claim 1, which Applicant has shown above to be allowable. Dependent Claims 7-9 depend from independent Claim 6, which Applicant has shown above to be allowable. Dependent Claim 13 depends from independent Claim 11, which Applicant has shown above to be allowable. Accordingly, dependent Claims 2-3, 5, 7-9, and 13 are not obvious over the *Andrews-Walsh* combination at least because they include the limitations of their respective independent claims. Additionally, dependent Claims 2-3, 5, 7-9, and 13 recite elements that further distinguish the art. As just one example, Claim 2 recites “a sibling pruning indicator display element which is included in the display to indicate to a user of the display that data elements which are siblings of an identified data element within the immediate parent directory exist within the data set but have been omitted from the display and replaced by the sibling pruning indicator display element.” As another example, Claim 8 recites that “the display engine is operable to substitute a sibling pruning indicator display element for data elements which are siblings of the particular identified data element within the parent subdirectory.” The Examiner relies on *Walsh* for disclosure of these features. As discussed above, however, the symbols used in the graphical display disclosed in *Walsh* merely indicate whether the contents of each directory, subdirectory, and sub-subdirectory are completely displayed or completely hidden. Each directory, subdirectory, and sub-subdirectory is listed. Thus, for reasons similar to those discussed above with regard to Claim 1, Applicant respectfully submits that the above-recited features are completely absent from the teachings of *Walsh*. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 2-3, 5, 7-9, and 13.

The Examiner rejects Claims 4, 10, and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Andrews* in view of U.S. Patent No. 5,973,695 issued to Walsh et al. (“*Walsh*”) and further in view of U.S. Patent No. 6,304,790 issued to Nakamura et al. (“*Nakamura*”).

Dependent Claim 4 depends upon independent Claim 1, which Applicant has shown above to be allowable. Dependent Claims 10 and 12 depend from independent Claim 11, which Applicant has shown above to be allowable. Accordingly, dependent Claims 4, 10, and 12 are not obvious over the proposed combination at least because they include the limitations of their respective independent claims. Additionally, dependent Claims 2-3, 5, 7-9, and 13 recite elements that further distinguish the art. Because Applicant has shown independent Claims 1 and 11 to be allowable, however, Applicant has not provided detailed arguments with respect to dependent Claims 4, 10, and 12. However, Applicant remains ready to do so if it becomes appropriate. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 4, 10, and 12.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant does not believe any fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
Baker Botts L.L.P.
Attorneys for Applicant



Kevin J. Meek
Reg. No. 33,738
(214) 953-6680

Dated: July 1, 2004

CORRESPONDENCE ADDRESS:

at Customer No. 35005



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Name of Inventor(s): Bernard J. Solomon

Title of Invention: SLM for Compiling and Displaying

Client or Applicant: EDS BB File No.: 014208.1481

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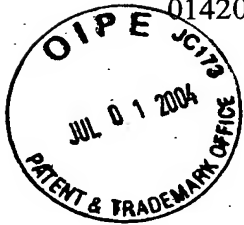
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Bernard J. Solomon
Serial No.: 10/034,231
Filing Date: December 27, 2001
Group Art Unit: 2172
Examiner: Unknown
Title: SYSTEM AND METHOD FOR COMPILING AND
DISPLAYING A PRUNED INFORMATION SET

Commissioner of Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INFORMATION DISCLOSURE STATEMENT

Applicant respectfully requests, pursuant to 37 C.F.R. §§ 1.56, 1.97 and 1.98, that the references listed on the attached PTO-1449 form be considered and cited in the examination of the above-identified patent application. Copies of the references are enclosed for the convenience of the Examiner. No representation is made that a search has been made, that the references are material to the patentability of the present application, or that the references qualify as prior art. The items contained in this Information Disclosure Statement were first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.

REMARKS

This Information Disclosure Statement is being submitted pursuant to 37 C.F.R. § 1.97(b) before the issuance of a first Office Action and, therefore, no fee is believed to be due. If, however, a fee is due, the Commissioner is authorized to charge such fee to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

Baker Botts L.L.P.
Attorneys for Applicant

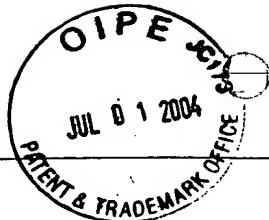


Kevin J. Meek
Reg. No. 33,738

Date: April 6, 2004

Correspondence Address:
Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
Phone: (214) 953-6680

Customer No. **35005**



PTO-1449	Application No. 10/034,231		Applicant(s) Bernard J. Solomon	
	Docket Number 014208.1481	Group Art Unit 2172	Filing Date December 27, 2001	

**Information Disclosure Citation
In an Application**

U.S. PATENT DOCUMENTS

		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE
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NON-PATENT DOCUMENTS

		DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
	M	PCT Search Report for PCT/US 02/38939, 6 pages	February 3, 2004
	N	Desclefs et al., XP-002163254, "Navigation in Huge Information Hierarchies," pp. 1-15	
	O	Hearst et al., XP-000782010, "Cat-a-Cone: An Interactive Interface for Specifying Searches and Viewing Retrieval Results using a Large Category Hierarchy," pp. 246-255	1997
	P	Kumar et al., XP-002088976, "Browsing hierarchical data with multi-level dynamic queries and pruning," pp. 103-124	1997
	Q	Kaugars, XP-008012937, "OTree: A Tree Visualization using Scaling and Omission," pp. 491-496	1999
	R		
	S		

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.

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